

### **REMARKS/ARGUMENTS**

Claims 1-5, 7-16 and 18-21 are pending in this application. The Examiner's attention is, however, directed to the "Office Action Summary" in the present Office Action which states, incorrectly, that claims 1-16 and 18-21 are pending. Claim 6 was previously canceled in applicant's Amendment filed October 23, 2006 and applicant respectfully submits that the mention of claims 1-16 and 18-21 as the pending claims in the Office Action appears to be due to a typographical error. The Examiner is, therefore, respectfully requested to confirm that the pending claims are actually nos. 1-5, 7-16 and 18-21 in her next Communication concerning this application.

Claim 1 has been amended herein to more clearly define applicant's invention. The amendments to the subject claim are entirely supported by the specification as originally filed, at p. 4, lines 19-23, page 10, lines 12-16 and Figure 4 (see, e.g., item "18"). No new matter is thus added by these amendments.

Entry of this "Amendment Under 37 C.F.R. 1.116" into the file of the application is respectfully requested as it is believed to place the entire application in condition for allowance or, at a minimum, to materially reduce the issues for an appeal. Upon such entry, claims 1-5, 7-16 and 18-21, as amended, will remain in the application.

Applicant wishes to express his appreciation for the courtesies extended by Examiner Zeinab E. El-Arini to his representative, Mark A. Farley, Esq. during a telephonic interview held on Friday, March 9, 2007. During the interview, applicant's representative argued that the Sylvain U.S. Patent No. 5,932,025 does not disclose or even suggest the sealing arrangement recited in claim 1 as presented in the Amendment filed October 23, 2006. Said representative additionally argued that the combination of Sylvain with either or both of the patent to Pugh et al. (USP 5,566,694) and/or the published United States patent application of Volz, et al. (US 2004/0099292 A1) would not suggest to one having ordinary skill in this art the method claimed by applicant or the device recited in claim 21 as presented in the October 23<sup>rd</sup> Amendment.

An agreement with regard to the patentability of applicant's claims was not, however, reached with the Examiner who chose, instead, to maintain her rejections. Thus, claims 1-5, 7-16 and 18-21 remain rejected under §103(a) over Sylvain (5,932,025) in combination with Wissman et al. (6,427,706), Pugh et al. (5,566,694), Volz et al. (2004/0099292) and Ammermann et al. (5,579,799),

Upon further consideration of the Examiner's position, although applicant continues to believe that his invention as claimed in the October 23<sup>rd</sup> Amendment is distinguishable over the cited art, in an effort to advance the prosecution of this application claim 1 has been further amended to more clearly recite what applicant perceives as constituting his invention. It is, therefore hoped that the Examiner will agree that the subject amendments serve to further distinguish the invention over all of the prior art cited to reject applicant's claims. As now amended, claim 1 recites, *inter alia*, "at least one horizontal seal located at a contact surface between the treatment tank and the at least one pump circulation tank, wherein said at least one seal substantially prevents escape of volatile constituents of said treatment liquid from said ump circulation tank.". As indicated above, the amendments made to claim 1 are entirely supported by the application as originally filed and thus they raise no issue of new matter. As now amended, therefore, the invention recited in the subject claim is believed to be even further distinguishable, for the reasons set forth below, over the prior art cited to reject the claims.

The following is a brief summary of what applicant's and his representatives perceive as the Examiner's position with regard to the Sylvain '025 patent. The Examiner referred, during the interview, to item no. 32 in Fig. 3 which is discussed in the paragraph set forth at col. 3, lines 11-15 of the subject patent. The Examiner indicated that, in her view, "sealing layer 32" could or would extend vertically upward from the broken-away portion where it is shown in Fig. 3 such that it would extend adjacent to the 'upper' tank, such that it would provide a contact surface between the treatment tank and the at least one pump circulation tank and wherein this contact surface would serve the purpose of a seal.

Assuming the above to be a correct interpretation of the position espoused by the Examiner, applicant respectfully traverses the Examiner's interpretation for the reasons which follow.

Although in the description found in col. 3 at lines 11-15 of the Sylvain U.S. '025 patent the side walls of the lower tank are described as having a "sealing layer 32", this sealing layer is NOT the same as the claimed seal between the treatment tank and the pump circulation tank when those two parts are combined. The sealing arrangement claimed for use with the present invention is positioned and arranged in order to solve an entirely different problem than that solved by 'sealing layer 32' as described by the reference. In the present invention the contact surface comprising a seal (as recited in the version of claim 1 presented in applicant's previous

response) provides a gastight sealing between the treatment tank and the at least one pump circulation tank. In contrast, however, the 'seal' described by Sylvain is used to assure a safe storage of the treatment fluid (i.e., a pickling acid) when using a metallic enclosure coated with a refractory material. One having ordinary skill in this field would not find any suggestion in Sylvain to produce the claimed sealing arrangement which would serve to prevent the leakage of volatile vapors produced by the liquid in the (at least one) pump circulation tank. This is due, *inter alia*, to the fact that the Sylvain reference contains no teaching (or suggestion) that the rubber material used for sealing layer 32 is used to seal the contact surface between the upper and lower tanks. Applicant, therefore, respectfully submits that any such interpretation is based upon a hindsight reliance upon the teachings found in applicant's own specification, which is a prohibited basis for making a rejection under §103(a).

Further to the above, moreover, in further support of applicant's contention that layer 32 does not serve as a seal between the upper and lower tanks, applicant submits that, if layer 32 did operate as postulated by the Examiner, the 'sealing effect' would be produced by vertical seals arranged on opposed vertical surfaces located on the lower tank at either side of the upper tank. This would mean that there would be substantial pressures placed on these vertical contact surfaces due to the fact that, as would be well known by one of ordinary skill in this art, the upper tank is a very large part, i.e., it may be more than 20 meters in length and many tons in weight. If one were to attempt to construct an arrangement with such a large and heavy tank between two vertical sealing surfaces, the seals would likely be damaged each time the tank was removed or installed, leading to significant 'down time' of the system as well as substantial increases in costs due to the system being out of service and for the repairs necessary to place it back into service.

Thus, for the reasons above applicant respectfully submits that the arrangement described in Sylvain is not the same as, nor would it suggest, the sealing arrangement taught for use in applicant's invention. Nevertheless, as indicated above, in an attempt to advance the prosecution of this application applicant has amended claim 1 of this application to even further distinguish the invention over the cited art. As noted above, as now amended the subject claim now recites that the device according to the invention comprises, *inter alia*, at least one horizontal seal at a contact surface between the treatment tank and the at least one pump circulation tank, wherein

the at least one seal substantially prevents escape of a volatile constituents of the treatment liquid from the pump circulation tank.

Applicant respectfully submits that nowhere in Sylvain is there any disclosure which teaches or even suggests the presence of such a horizontal seal as now claimed at a location between the two tanks. That is, the seal is now claimed as being both horizontal and as a separate element, i.e., separate from the wall forming either of said tanks, i.e., it does not form part of a wall constituting one said tank as is the case with Sylvain. Furthermore, as noted above, the only discussion in Sylvain relating to a seal is that found at col. 3, lines 11-15. However, there is NO disclosure at that location which would teach or even suggest to use such a sealing arrangement as now recited in claim 1 which would substantially prevent escape of vapors from the (at least one) pump circulation tank. Based upon the reasoning presented above, therefore, applicant respectfully submits that claim 1 and the claims depending therefrom are distinguishable over the Sylvain reference.

Further to the above, applicant additionally submits that none of the so-called 'secondary' references cited by the Examiner (i.e., Wissmann, et al., Pugh et al., Volz, et al. and/or Ammermann, et al.) contain any teaching or disclosure which would provide the element(s) of the claimed invention missing from Sylvain, notably (but not limited to) the sealing arrangement recited in claim 1 and thus applicants device claims (excluding claim 21 which is discussed separately below) are believed to distinguish the invention over the art cited in combination in the present Office Action. The Examiner is, therefore, respectfully requested to withdraw the rejection of applicant's device claims.

The following discussion is, thus, now directed to applicant's method claims, i.e., nos. 16, 18 and 19 and to the second independent device claim, i.e., no 21, which does not contain the limitation added to claim 1 but is believed to be distinguishable on the same bases as the method claims, as explained below.

As applicant's representative indicated during the interview, the rejection of the method claims is believed to be based on the following line of thought by the Examiner, at least as far as this rejection is explained in the present Office Action. As applicant sees it, the Examiner is saying that Sylvain essentially discloses the invention as recited, e.g., in claim 16, except for the feature(s) wherein both the treatment tank and the circulation tank are equipped with a sloped bottom to facilitate quick and complete emptying of said tanks. As an aside to the above,

moreover, the same feature is included in independent device claim no. 21. In the Office Action, the Examiner indicates that, in her view, the feature(s) of the claimed invention (i.e., as recited in claims 16 and 21) missing from Sylvain would be provided by one or more of the Pugh, et al. and/or Volz, et al. references, and further, that it would be obvious to combine one or both of these references with Sylvain in order to arrive at applicant's claimed invention. This rejection is respectfully traversed by the applicant.

Applicant's representative pointed out to the Examiner during the interview that for two or more references to be combined in support of an 'obviousness' rejection under §103, there must be some 'teaching, suggestion or motivation' which would warrant the indicated combination by one having ordinary skill in the relevant art. In applicant's view these are entirely lacking in the presently cited references. That is, Sylvain contains no teaching or suggestion which identifies either quick or complete emptying of the tanks as being anything of a problem which requires a solution. Thus there is no discussion regarding any interest on the part of Mr. Sylvain (the patentee) in finding a better way to achieve these ends. When the Examiner was requested to identify where, in Sylvain, this issue was discussed or otherwise described as a problem which needed a solution she, in fact, could not.

Applicant submits, therefore, that notwithstanding what Pugh, et al. and/or Volz, et al. may or may not teach with regard to the effects of providing a sloped floor on either or both of the treatment and pump circulation tanks, there is no teaching, suggestion or motivation to combine the disclosure contained in these references with Sylvain in an effort to achieve the presently claimed method and the device recited in claim 21. Such a showing as indicated above, i.e., of a teaching, suggestion or motivation to combine is not an option for supporting a rejection under §103(a). Rather, it is, in fact required in order to maintain the subject rejection pursuant to various decisions concerning this issue by the Court of Appeals for the Federal Circuit. Applicant respectfully submits that no such showing of any teaching, suggestion or motivation can be shown in either or both of the 'secondary references' because they are not present in these cited prior art publications.

For the reasons above, therefore, the Examiner is respectfully requested to reconsider and withdraw the rejection of applicant's method claims, as well as that of device claim 21.

### Summary

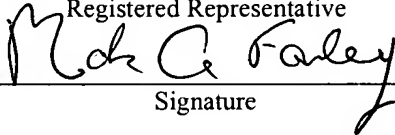
The applicant, again, wishes to express his appreciation for what is believed to be a very productive interview with the Examiner. Based upon the results of the interview, applicant respectfully submits that the claim amendments and arguments presented above are sufficient to overcome all of the Examiner's grounds for rejection of the claims. Entry of this Amendment, therefore, and an allowance of the entire application on the basis thereof, is respectfully solicited.

If the Examiner does not agree and believes that a further interview would advance the progress of this application, she is respectfully invited to telephone applicant's representative at the number below and another such interview will be scheduled.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on : March 19, 2007

Mark A. Farley

Name of applicant, assignee or  
Registered Representative



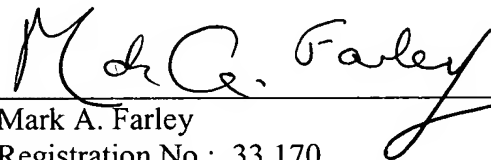
Signature

March 19, 2007

Date of Signature

MAF:jl

Respectfully submitted,



Mark A. Farley

Registration No.: 33,170

OSTROLENK, FABER, GERB & SOFFEN, LLP

1180 Avenue of the Americas

New York, New York 10036-8403

Telephone: (212) 382-0700